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EXAMINER

JONES, HUGH M

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/281,042

Applicant(s)

Aguro

Examiner
Hugh Jones

Art Unit
2123



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/15/2002; 7/8/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Mar 29, 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13 6) ☐ Other:

Art Unit: 2123

DETAILED ACTION

Introduction

1. The action is in response to the paper 13 (IDS - 10/5/2001), paper # 14 (amendment C - 10/5/2001), paper # 19 (Appeal Brief - 3/5/2002), paper # 22 (Petition - 7/8/2002), paper # 23 (Decision re Petition - 8/15/2002) and paper # 24 (Revised Appeal Brief - 7/8/2002). New prior art rejections are applied - consequently, this action is made non-final.

Specification

2. The title of the invention as recited on the Appeal Brief is not descriptive. Applicants have changed the title from "Computer System" to "Security System for Integrated Circuit Computer System" (paper # 10), although they still regard "Computer System" as the title in the Revised Appeal Brief (paper # 24). The following title was suggested in paper # 8: "Utilizing password registers to block scan-path access". That or similar phraseology should be used because scan-port access/denial through the use of registers and passwords is central to that which Applicants regard as their invention.

Claim Objections

3. The following is a quotation of 37 C.F.R. § 1.75 (d)(1):

The claim or claims must conform to the invention as set forth in the remainder of the specification and terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

Art Unit: 2123

4. **Claims 5-7, 10-13, 15-17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.** Applicant is required to cancel the claim(s)/limitations, or amend the claim(s)/limitations to place the claim(s)/limitations in proper dependent form, or rewrite the claim(s)/limitations in independent form.

- Claims 5, 10, 15 recite that the plurality of commands are applied in a specific time sequence. It is inherent that a plurality of commands which are applied are applied in a specific time sequence.

- Claims 6, 7, 11-13, 16-17 also recite a comparator. However, the respective independent claims reciting "comparing" - it is inherent that a comparator would be required to carry out such a comparison.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 4-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.** Applicants state (page 3, third paragraph, paper # 24 - Revised Appeal Brief) that

Art Unit: 2123

support for the claimed program exists at page 16, lines 15-23, specification. There is no disclosure relating to the claimed program other than mere mention of such a program. It would require undo experimentation for one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. **Claims 4-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.** Applicants state (page 3, third paragraph, paper # 24 - Revised Appeal Brief) that support for the claimed program exists at page 16, lines 15-23, specification. There is no disclosure relating to the claimed program other than mere mention of such a program.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claim 8, 10 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.** See MPEP § 2172.01. there is insufficient detail describing the relationship between the input ports, the processor and the program and how the password is actually generated.

10. **Claims 8, 10 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections.** See MPEP

Art Unit: 2123

§ 2172.01. The omitted structural cooperative relationships are: there is insufficient detail describing the relationship between the input ports, the processor and the program.

11. **Claims 8, 11, 13 recite the limitation "said switching circuit" (see paper # 24 - Revised Appeal Brief).** There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. **Claims 14-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Palmer, Jr. et al. U.S. Patent 4,700,296.**

14. As regards Claim 14, Palmer Jr. et al. reference teaches; A security system for an integrated circuit computer system (All of Figures 1, 2 and 3 and Col. 2 Lines 50-54) comprising: applying a plurality of commands to a plurality of ports for a processor of said system (Figure 1 Items 6a, the block labeled PROCESS CONTROL PROGRAM, Item 4, Item 6f); a program stored in a memory coupled to said processor for operating said processor to process said plurality of commands to produce a password; (Figure 2 Item 6i and Item 6c and Col. 1 Lines

Art Unit: 2123

37-56); comparing said produced password with a predetermined password (Figure 1 Item 6 PARAMETER STORAGE REGISTERS, and Figure 2, Item 6i PARAMETER STORAGE and Col. 8 Lines 12-32).

15. Claims 14-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Angelo.

16. Angelo discloses a method for enabling power to all or portions of a computer system based upon the results of a two-piece user verification process that is completed as part of a secure power-up procedure. *At some point during the secure power-up procedure, the computer user provides an external token or smart card that is coupled to the computer through specialized hardware.* The token or smart card is used to store an encryption algorithm furnished with an encryption key that is unique or of limited production. *The computer user is then required to enter a plain text user password. Once entered, the user password is encrypted using the encryption algorithm contained in the external token to create a system password. The system password is compared to a value stored in secure memory.* If the two values match, the power-on sequence is completed and power to the computer system and/or secured computer resources is enabled. If the two values do not match, power to the entire computer system and/or secured computer resources is disabled. The two-piece nature of the authorization process requires the presence of both the user password and the external token in order to generate the system password. *Angelo also discloses (col. 9) that when the user is prompted to enter a plain text power-on password, as an alternative to a memorized value, the plain text password could*

Art Unit: 2123

be generated with the aid of biometrics. For example, a scanned fingerprint could be converted into a plain text password value. See col. 1-2 for general background; col. 3, lines 16-36; fig. 2 and corresponding text; col. 7-9.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. **Claims 4, 5, 8, 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer, Jr. et al. U.S. Patent 4,700,296 in view of Raghavavhari U.S. Patent 5,774,545.**

Art Unit: 2123

20. As regards Claim 4 the Palmer, Jr. et al. reference discloses an integrated circuit computer system (Figure 2, Item 6i) having a processor interconnected with memory (Figure 1, Item 6d and Col. 5 Lines 32-65) and peripheral circuits on said integrated circuit (Figure 1 Items 6f and 6c and 6a). A security means (Figures 1-6 and Col. 1 Lines 30-61) comprising: a plurality of input ports for said processor (Figure 1 Items 6b, 6c, 6d, 6e note the direction of the arrows to the Process Control Program and Col. 2 Lines 50-68 and Col. 3 Lines 1-4); a program stored in said memory to operate said processor (Figure 1, Process Control Program and Item 6d Code Table (ROM)), to receive a plurality of commands to said plurality of input ports to process said commands to produce a password (Figure 1 Items 6c, Item 4 and Figure 2 Item 6c and Figure 4 and Figure 5 and Col. 1 Lines 37-56 and Col. 5 Lines 32-65) which is compared with a predetermined password (Figure 2 Item labeled LOOK-UP TABLE and Col. 7 Lines 33-38), and a switching circuit is responsive to said comparison (Col. 4 Lines 36-50).

21. The Palmer, Jr. et al. reference does not expressly disclose, a scan-path interface circuit for reading out the predetermined memory or register in said system.

22. The Raghavachari reference discloses that many integrated circuits are accessed via scan ports and specifically discloses a scan-path interface circuit (Figure 1 Item 15 and Col. 13 Lines 10-13) as part of a security system requiring password authentication through comparison of an input password from an external device with a pre-stored password (Figures 1-10 and Col. 13 Lines 4-67 and Col. 14 Lines 1-67 and Col. 15 Lines 1-29 and Col. 16 Lines 1-29).

Art Unit: 2123

23. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the Palmer, Jr. et al. reference with the Raghavachari reference because, (motivation to combine) by protecting the scan-path interface with a password the integrated circuit is rendered useless to those who cannot meet the random security challenge and therefore reduces the value of the integrated circuit to potential thieves, (Raghavachari, Col. 1 Lines 45-61).

24. As regards Claim 8 the Palmer, Jr. et al. reference discloses an integrated circuit computer system (Figure 2, Item 6i) having a processor interconnected with memory (Figure 1, Item 6d and Col. 5 Lines 32-65) and peripheral circuits on said integrated circuit (Figure 1 Items 6f and 6c and 6a) coupled to a security system (Figures 1-6 and Col. 1 Lines 30-61) comprising:

a plurality of input ports for said processor, (Figure 1 Items 6b, 6c, 6d, 6e note the direction of the arrows to the Process Control Program and Col. 2 Lines 50-68 and Col. 3 Lines 1-4).

a program stored in said memory to operate said processor (Figure 1, Process Control Program and Item 6d Code Table (ROM)), to receive a plurality of commands to said plurality of input ports to produce a password (Figure 1 Items 6c, Item 4 and Figure 2 Item 6c and Figure 4 and Figure 5 and Col. 1 Lines 37-56 and Col. 5 Lines 32-65) which is compared with a predetermined password (Figure 2 Item labeled LOOK-UP TABLE and Col. 7 Lines 33-38).

25. The Palmer, Jr. et al. reference does not expressly disclose a scan-path interface circuit.

Art Unit: 2123

26. The Raghavachari reference discloses that many integrated circuits are accessed via scan ports and specifically discloses a scan-path interface circuit (Figure 1 Item 15 and Col. 13 Lines 10-13) as part of a security system requiring password authentication through comparison of an input password from an external device with a pre-stored password (Figures 1-10 and Col. 13 Lines 4-67 and Col. 14 Lines 1-67 and Col. 15 Lines 1-29 and Col. 16 Lines 1-29).

27. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the Palmer, Jr. et al. reference with the Raghavachari reference because, (motivation to combine) by protecting the scan-path interface with a password the integrated circuit is rendered useless to those who cannot meet the random security challenge and therefore reduces the value of the integrated circuit to potential thieves, (Raghavachari, Col. 1 Lines 45-61).

28. As regards Claim 9 the Palmer, Jr. et al. reference does not expressly disclose a switching circuit coupled to said scan-path interface.

29. The Raghavachari reference discloses that many integrated circuits are accessed via scan ports and specifically discloses a switching circuit coupled to said scan-path interface (Figure 1 Items 15 and 13, Figure 5 Items 56, 55, 51, Figure 8 Items 81, 82, 83 and Col. 2 Lines 60-67, Col. 3 Lines 1-40), and responsive to said comparison for switching said scan-path interface circuit (Figure 5 and Col. 7 Lines 30-41), between a first mode in which it is enabled (Figure 9, note the control flow diamond decision symbol that states "PASSWORDS MATCH?" after this symbol, follow the arrow for the, YES result, to the computational steps rectangle symbol

Art Unit: 2123

wherein, the item labeled "1. UNLOCK THE DEVICE") and a second mode in which it is disabled (Figure 9, note the control flow diamond decision symbol that states "PASSWORDS MATCH?" after this symbol, follow the arrow to the, NO result to the computational steps rectangle symbol wherein, the item labeled "1.INCREMENT FAILURE COUNT REGISTER, follow the arrows in the flow chart to the control decision symbol that states "SECURITY PASSWORD RECEIVED" and note that a, NO result, creates a loop back into that control decision symbol and NEVER sets the needed bits in the SECURITY STATUS REGISTER required to enable the scan-path port to operate).

30. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the Palmer, Jr. et al. reference with the Raghavachari reference because, (motivation to combine) by protecting the scan-path interface with a password the integrated circuit is rendered useless to those who cannot meet the random security challenge and therefore reduces the value of the integrated circuit to potential thieves, (Raghavachari, Col. 1 Lines 45-61).

31. As regards Claims 5 and 10, the Palmer, Jr. et al. reference inherently discloses a specified time sequence.

32. The Raghavachari reference also discloses receiving a plurality of commands which are applied to said plurality of ports in a specific time sequence (Figures 9, 10 and Col. 9 Lines 49-66, Col. 10 Lines 1-67, Col. 11 Lines 1-67, Col. 12 Lines 1-60).

Art Unit: 2123

33. Claims 6, 7, 11, 12, 13, 16, 17, 19, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer, Jr. et al. U.S. Patent 4,700,296 in view of Raghavavhari U.S. Patent 5,774,545 and in further view of Jacobson et al. U.S. Patent 5,784,577.

34. As regards Claims 6, 7, 11, 12, 13, 16 and 17 the Palmer et al. reference does not expressly disclose; a pair of registers, one of said registers receiving said produced password and the other of said registers containing said predetermined password; and a comparator for comparing the contents of said registers.

35. The Jacobson et al. reference discloses; a pair of registers (Figure 3, Items 301 and 302), one of said registers receiving said produced password (Figure 3 Item 302) and the other of said registers containing said predetermined password (Figure 3 Item 301) a comparator for comparing the contents of said registers (Figure 3 Item 303) for controlling a Data Protect Circuitry (Figure 3 Item 306).

36. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the Palmer, Jr. et al. reference with the Jacobson et al. reference because, (motivation to combine) a need arises for an accurate, overridable method of tracking versions of the PLDs, as well as preventing unauthorized users from programming the PLDs, (Jacobson et al. Col. 2 Lines 10-13).

37. As regards Claims 19, 20 and 21, the Palmer, Jr. et al. reference does not expressly disclose; a scan-path interface circuit for comparison with a predetermined memory or register, and a switching circuit that is responsive to said comparison to switch operation of said scan-path

Art Unit: 2123

interface between enabled and disabled modes. (It is noted by the examiner that the Palmer, Jr. et al. reference does disclose a switching circuit and a comparison of a predetermined memory or register, responsive to said comparison of an externally provided password with a predetermined password, the ONLY limitation not disclosed in the Palmer, Jr. et al. reference is a scan-path interface).

38. The Jacobson et al. reference discloses a scan-path interface circuit (Col. 1 Lines 42-55, Col. 4 Lines 39-42) for reading out contents of a predetermined memory or register in said system (Figure 3, Item 300 and Col. 2 Lines 15-45) and a switching circuit responsive to said comparison to switch operation of said scan-path interface between enabled and disabled modes, (all of Figure 3 and Figure 2 and Col. 3 Lines 14-67, Col. 4 Lines 1-49).

39. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the Palmer, Jr. et al. reference with the Jacobson et al. reference because, (motivation to combine) ...a need arises for an accurate, overridable method of tracking versions of the PLDs, as well as preventing unauthorized users from programming the PLDs (Jacobson et al. Col. 2 Lines 11-13).

40. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer, Jr. et al. U.S. Patent 4,700,296 view of Jacobson et al. U.S. Patent 5,784,577.

41. The Palmer, Jr. et al. reference does not expressly disclose; a scan-path interface circuit for comparison with a predetermined memory or register, and a switching circuit that is responsive to said comparison to switch operation of said scan-path interface between enabled

Art Unit: 2123

and disabled modes. (It is noted by the examiner that the Palmer, Jr. et al. reference does disclose a switching circuit and a comparison of a predetermined memory or register, responsive to said comparison of an externally provided password with a predetermined password, the ONLY limitation not disclosed in the Palmer, Jr. et al. reference is a scan-path interface).

42. The Jacobson et al. reference discloses a scan-path interface circuit (Col. 1 Lines 42-55, Col. 4 Lines 39-42) for reading out contents of a predetermined memory or register in said system (Figure 3, Item 300 and Col. 2 Lines 15-45) and a switching circuit responsive to said comparison to switch operation of said scan-path interface between enabled and disabled modes, (all of Figure 3 and Figure 2 and Col. 3 Lines 14-67, Col. 4 Lines 1-49).

43. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the Palmer, Jr. et al. reference with the Jacobson et al. reference because, (motivation to combine) ...a need arises for an accurate, overridable method of tracking versions of the PLDs, as well as preventing unauthorized users from programming the PLDs (Jacobson et al. Col. 2 Lines 11-13).

44. Claims 4-13, 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angelo in view of Bianco et al..

45. Angelo discloses a method for enabling power to all or portions of a computer system based upon the results of a two-piece user verification process that is completed as part of a secure power-up procedure. *At some point during the secure power-up procedure, the computer user provides an external token or smart card that is coupled to the computer through*

Art Unit: 2123

specialized hardware. The token or smart card is used to store an encryption algorithm furnished with an encryption key that is unique or of limited production. *The computer user is then required to enter a plain text user password. Once entered, the user password is encrypted using the encryption algorithm contained in the external token to create a system password. The system password is compared to a value stored in secure memory.* If the two values match, the power-on sequence is completed and power to the computer system and/or secured computer resources is enabled. If the two values do not match, power to the entire computer system and/or secured computer resources is disabled. The two-piece nature of the authorization process requires the presence of both the user password and the external token in order to generate the system password. *Angelo also discloses (col. 9) that when the user is prompted to enter a plain text power-on password, as an alternative to a memorized value, the plain text password could be generated with the aid of biometrics. For example, a scanned fingerprint could be converted into a plain text password value.* See col. 1-2 for general background; col. 3, lines 16-36; fig. 2 and corresponding text; col. 7-9.

46. Angelo does not expressly disclose; a *scan-path* interface circuit for comparison with a predetermined memory or register, and a switching circuit that is responsive to said comparison to *switch operation of said scan-path* interface between enabled and disabled modes.

47. Bianco et al. disclose a set/scan test capability which is provided for a circuit that includes sensitive subcircuits, but that can be latched out to prevent reverse engineering the sensitive elements. A mechanism to inhibit set/scan test access to at least some of the sensitive

Art Unit: 2123

subcircuits is selectively actuated by a control circuit to override a normal set/scan test and inhibit set/scan access to the sensitive subcircuits. Various implementations are possible, such as fusible-link PROMs for irreversibly inhibiting set/scan access to the sensitive subcircuits after an initial non-inhibited test period, the use of encryption codes to enable repeated set/scan access to the sensitive subcircuits, and an erasable/reprogrammable mechanism for inhibiting set/scan access to programmed sets of subcircuits. See col. 1 to col. 2, line 26 for need to protect integrated circuits; col. 2, line 29 to col. 3, line 8; fig. 6 and corresponding text.¹

48. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the Angelo reference with the Bianco et al. reference (motivation to combine) for the following reasons. Bianco states that integrated circuitry is subject to reverse engineering and should be protected (col. 1-2). Bianco discloses enhancing the testability of ICs that contain sensitive circuitry through the use of the set/scan test technique, while preventing the disclosure of the sensitive circuitry design to unauthorized parties. In so doing the invention allows sensitive subcircuits to be removed from the set/scan test chain. The removal can be permanent, or the sensitive subcircuits can be included in the set/scan chain in response to the application of a control code by an authorized user. The manufacturer is provided with full testability during device fabrication, while access to the sensitive elements can be restricted once the device is delivered; copiers are thereby prevented from exploiting the set/scan capability to obtain design details required for the production of unauthorized copies. The invention is compatible with, and enhances the strength of, other anti-reverse engineering measures such as opaque die coatings or

Art Unit: 2123

the techniques disclosed in U.S. Pat. No. 4,766,516. Bianco discloses the need for a mechanism to inhibit set/scan test access to at least some of the IC's sensitive subcircuits, and a mechanism for overriding a normal set/scan test by actuating the inhibit mechanism for the sensitive subcircuits while permitting set/scan access to the remaining subcircuits.

Response to Arguments

49. Applicant's arguments filed 10/5/2001, 3/5/2002, 7/8/2002 and 7/8/2002 have been fully considered but they are not persuasive. This action is also responsive to paper # 23 (Decision re Petition).

Response to Arguments - IDS

50. Applicant's remarks regarding the IDS are persuasive. **The Examiner unambiguously states, for the record, that the IEEE standard has not, and is not at this time, being applied or considered as prior art.** Applicants are also thanked for their IDS (paper # 13). **Applicants have fully discharged their duty as per the requirements of 37 C.F.R. 1.56.** All requirements/requests for information have been withdrawn.

Response to Arguments - 112 rejections

51. The 112(1) rejections are withdrawn (except as noted earlier) in view of pages 3-4, paper # 24 (Summary of the Invention - Revised Appeal Brief) wherein Applicants indicate support for

Art Unit: 2123

their claims. The 112(2) are maintained or changed as noted earlier. Applicants' arguments relating to system and method claims are noted but not persuasive.

Response to Arguments - prior art rejections

52. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

53. **Any inquiry concerning this communication or earlier communications from the examiner should be:**

directed to:

Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, *or* the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

Art Unit: 2123

(703) 308-9051 (for formal communications intended for entry)

or (703) 308-1396 (for informal or draft communications, please label "*PROPOSED*" or "*DRAFT*").

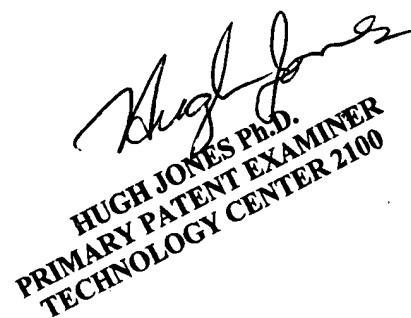
Hugh Jones Ph.D.

Primary Patent Examiner

March 9, 2003



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HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
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